

REMARKS

Claims 33-35, 38-39 and 40-42 are rejected under 35 U.S.C. §103(a) as obvious over Plourde, U.S. Patent No. 5,457,918 in view of Haldric et al., U.S. Patent No. 4,852,380 and Lesar, U.S. Patent No. 5,524,855 in view of Haldric et al. Claims 36-39 and 41 are rejected based on additional art. Applicants respectfully traverse these rejections.

The Manual for Patent Examining Procedure (MPEP) §2142 sets forth the standard for making a *prima facie* case of obviousness and rejecting a claim under 35 U.S.C. §103(a) as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §§ 2143 - §§ 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP §§ 2144 - §§ 2144.09 for examples of reasoning supporting obviousness rejections.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). A statement of a rejection that includes a large number of rejections must explain with reasonable specificity at least one rejection, otherwise the examiner procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (Rejection based on nine references which included at least 40 prior art rejections without explaining any one rejection with reasonable specificity was reversed as procedurally failing to establish a *prima facie* case of obviousness.).

In the present rejection, the Examiner has failed to make a *prima facie* case of obviousness. Independent claims 33 recites, in part:

said anchoring portion and said holding portion being substantially hollow, wherein the anchoring portion is hammered from a cylindrical part; and

independent claim 35 recites, in part;

said anchoring portion and said holding portion being substantially hollow, wherein the anchoring portion is hammered from a cylindrical part.

A combination of the cited references fails to result in an operative hammered anchoring portion.

The Examiner has failed to provide proper motivation to combine the Haldric et al. reference with either the Plourde reference or the Lesar reference. The Haldric et al. reference cannot be successfully combined with either the Plourde reference or the Lesar reference. The Haldric et al. Reference teaches a device for corrugating a

tube. In the "Background of the Invention" section of the Haldric et al. reference, the reference teaches that corrugated tubes are used for absorbing differences in alignment or expansion and for absorbing energy. Thus, the corrugated tube is designed to deform. This design feature is contrary to the design of the present invention. The present invention is designed to be screwed or fastened into the ground. Therefore, the present invention must withstand forces acting upon it. Thus, the Examiner has failed to provide proper motivation to combine the references because one of ordinary skill in the art would not use the teaching of Haldric et al., i.e. a deformable member, to arrive at the present invention. Rather it appears the Examiner relied on hindsight and the teachings of the present invention to arrive at the present rejection.

In addition, there is no reasonable expectation of success that the teaching of Haldric et al. when combined with Plourde or Lesar would arrive at an operative embodiment. There is no indication that hammering the anchoring device of Plourde or the anchor of Lesar if modified by Haldric et al. would result in a sufficiently strong and durable anchoring device or anchor. Rather, the teachings of Haldric et al. with either Plourde or Lesar would result in a deforming anchor. For instance, force on an anchoring device as taught by Plourde and modified by Haldric et al. would result in a device that would bend when force is applied. When this device bends, objects which are for insertion into the device, i.e. an umbrella, can no longer

be inserted because the device is bent, or if the object is already inserted, it cannot be removed upon the device bending. Thus, the combination of references would not result in an operative invention. Accordingly, there is no reasonable expectation of success that the combination of references would arrive at an operative invention.

Further, the main technical difference between the invention and Haldric is considered to be actually the totally different object and technical field as well as final the destination. No application or indication of hammering a fastening or anchoring device to be introduced in the ground is given. This document concerns rather the production of tubes to be used in automotive technology, such as steering columns, which have specific characteristics, that means the deformation and elasticity in case of a car crash. For this purpose, a shock absorbing corrugated profile is produced at a cylindrical portion of the tube (see Fig. 2B and Fig- 2A). Therefore, the only teaching from this document would be to provide a device with a cylindrical portion having the corrugated form as in Figs. 2A and 2B in order to make it deformable.

The above teaching makes no sense in the technical field of anchoring devices, since they require a stiff material and non-deformable shape in order to resist the increased forces during introduction into the ground (screwing) and in order to be capable to receive the poles to be mounted. Since the reference concerns only

open tubes without any conical portion and without any fastening portion or screwing means, the skilled person has no suggestion to arrive at the invention.

In the Plourde patent, an anchoring device is disclosed having a hollow cylindrical portion and a conical bottom portion which is not hollow (Fig. 4). The method of production is obviously to cast or mold the complete device in a final shape. Afterwards, the center bore in the cylindrical portion (upper half) is realized by means of drilling (loss of material). This known anchoring device is therefore rather heavy and very complicated to produce. A combination of this document and Haldric would rather lead to a molded or cast anchoring device having a cylindrical hollow portion (upper half) on which a corrugated profile is provided on the outside. This would prevent the intended function of screwing the anchoring device into the ground. A corrugated form prevents a smooth screwing into the ground.

The hammering of the anchoring device according to the present invention has the advantage of an easy realization of a conical and cylindrical hollow form of the device. The hammering has further the advantage of a cold massive forming with a micro-structural change in the metal material which results in an increased resistance against deformation of the device. Warm forming methods do not lead to such an improvement of the microstructure of the material and require therefore walls of larger diameter and result in a heavier device. The casting and drilling of Plourde is time-consuming and a very expensive method of realization of anchoring devices.

Thus, the hammered device of the present invention leads to a device with structural differences over the Plourde reference.

Accordingly, as the cited art fails to teach or suggest the claimed invention, it is respectfully requested that all rejections under 35 U.S.C. §103(a) be withdrawn.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
Jordan and Hamburg LLP ✓

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

and,

by
By Jacqueline M. Steady
Jacqueline M. Steady
Reg. No. 44,354
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340